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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,384	07/06/2001	Shekhar Kirani	LS/0010.00	7192

8791 7590 10/12/2005

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT PAPER NUMBER

2143

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,384

Applicant(s)

KIRANI ET AL.

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 46-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33, 46-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to the amendment filed 7/27/05.
2. Claims 34-45 were cancelled. Claims 1-33 and 46-51 were elected and are pending for examination. The objection and rejection cited are as stated below.
3. Since claims 1-33 and 46-51 are subject to claiming Continuation In Part, the claimed inventions have been verified with the parent applicants 09/588875 filed 6/6/2000 and 60/203407 filed 06/11/2000. The parent applications do not support the claims' subject matter. Hence, they do not entitle to a benefit of earliest filing date. The claimed inventions therefore, have an effective filing as of 26/2001.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-33 and 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabe-Hesketh et al (WO 00/72534 A1) and Gabrielsson et al (WO 01/01663 A1).
7. Regarding claims 1, 4-6, 18, 46 and 51 Rabe-Hesketh discloses a method, apparatus and computer program (collectively referred to as "system") for automatically processing messages containing attachments, the method comprising: receiving a particular message having a particular attachment; removing the particular attachment from the particular message based on

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predefined criteria, e.g., size of the attachment; inserting a link into the particular message, said link capable of referencing the particular attachment that has been removed; in response to invocation of the link by the intended recipient, retrieving a copy of the particular attachment that is automatically formatted based on the specified preference (Rabe-Hesketh - Abstract, Page 3, Lines 25-37; Page 3, Line 24-PAGE 4, Line 25; Page 5, Line 25-PAGE 6, Line 25; Page 7, Line 20-PAGE 11, Line 37).

Rabe-Hesketh does not explicitly disclose specifying a preference for formatting attachments and does not explicitly apply predefined criteria in response to a client's capability, e.g., exceeding client capability.

However, in the same field of endeavor, a teaching that has objective akin to Rabe-Hesketh, Gabriellson teaches a system for communicated media object to an e-mail recipient, which is capable of modifying object format based on specified user preference (Gabriellson, Page 13, Lines 24-25). Furthermore, Gabriellson teach a process of thinning message size by removing message component and replacing with document identifier (Gabriellson, page. 8, lines 9-20). In addition, Gabriellson teaches the thinning process is implemented for accommodate client capability, e.g., suitable to client's capabilities, e.g., bandwidth, access capability (Gabriellson, page 8, lines 3-17).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Rabe-Hesketh by including, the teaching of using user preference and thinning message to accommodate client capabilities as taught by Gabriellson to enable Rabe-Hesketh's system to provide an object in accordance with user requirement and expand the predefined criteria in Rabe-Hesketh. In doing would enable Rabe-Hesketh's system

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to enhance its ability and flexibility in providing services to the users that have different levels of resources and capabilities (Gabrielsson – Abstract, Page 1, Line 20-Page 2, Line 8; Page 3, Lines 15-28; Page 4, Lines 9-32; Page 5, Lines 8-21; Page 6, Line 14-Page 8, Line 20; Pages 9, Lines 5-16; Page 12, Lines 9-25; Page 13, Lines 20-Page 14, Line 23).

8. Regarding claims 2 and 3, Rabe-Hesketh-Gabrielsson discloses, preference is associated with a particular user (Gabrielsson, Page. 13, Lines 24-25).

9. Regarding claims 7, 8 and 27, Rabe-Hesketh -Gabrielsson discloses preference includes specifying that attachments which comprise images be transformed from one file format to another (Gabrielsson - Page 13, Lines 24-25; Page 7, Line 25-Page 8, Line 8).

10. Regarding claim 9 and 49, Rabe-Hesketh -Gabrielsson discloses receiving the particular message at an SMTP server (Rabe-Hesketh, Page 4, Lines 21-26).

11. Regarding claim 10-11, Rabe-Hesketh -Gabrielsson discloses removing attachment could be done at anywhere server including a mail server or at MTA, which employed SMTP protocol. Implicitly, Rabe-Hesketh-Gabrielsson has readily taught removing an attachment at SMTP server or by the SMTP server.

12. Regarding claims 12-14, 47-48, Rabe-Hesketh -Gabrielsson discloses message includes a MIME attachment (Rabe-Hesketh – Page 3, Lines 24-37).

13. Regarding claims 15 and 33, Rabe-Hesketh -Gabrielsson discloses link comprises a Uniform Resource Locator (URL) referencing said attachment that has been removed (Rabe-Hesketh Page 6, Lines 2-8; Page 12, Lines 18-30).

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14. Regarding claims 16-17, 19-20 and 28, Rabe-Hesketh -Gabrielsson discloses copy of the particular attachment is automatically formatted when a request is received to retrieve the particular attachment (Gabrielsson – Page 3, Lines 19-27; Page 7, Line 25-Page 8, Line 20).

15. Regarding claims 21-22 and 26-, Rabe-Hesketh-Gabrielsson discloses the invention substantially, as described in claim 1, including a notion of thinning and filtering, which are clearly applicable for down scaling image size and removing image detail, e.g., resolution, fidelity or removing color, which consequently would decrease fidelity or resolution of the image (Gabrielsson - Page 7, Line 25-Page 8, Line 20).

16. Regarding claims 23, 30, Rabe-Hesketh-Gabrielsson discloses formatted copies of objects within the particular attachment are stored in a network repository (Rabe-Hesketh Fig. 2, storage 27; Gabrielsson - Fig. 1, storage 100, 120).

17. Regarding claim 24, Rabe-Hesketh-Gabrielsson discloses network repository is accessible by a Web browser for shared access among multiple participants (Rabe-Hesketh Fig4, 48; Fig 5A-5C).

18. Regarding claims 25, 31 and 32, Rabe-Hesketh-Gabrielsson discloses attachment includes JPEG-formatted digital images (Gabrielsson, Page 7, Lines 3-6).

19. Regarding claim 50, Rabe-Hesketh discloses attachment-processing module operates as a plug-in module to an e-mail server (Rabe-Hesketh - Fig. 2, MTA 2, plug-in 25).

Response to Arguments

20. Applicant's arguments filed 7/27/05 have been fully considered but they are not persuasive. In the remark applicant argued in substance that the prior art of record does not teach the process of removing file and replace with identifier, e.g., link is not in responsive to

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exceeding client's capability. The argument has readily been addressed in the body of the rejection above.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

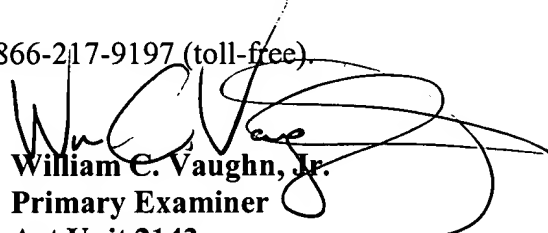
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (571) 272-3922. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William C. Vaughn, Jr.
Primary Examiner
Art Unit 2143
04 October 2005

/WCV